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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,237	06/15/2001	William George Bickel		7545

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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

17

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,237

Applicant(s)

BICKEL ET AL.

Examiner

Nini F. Legesse

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's response to office action of 09/04/03 is acknowledged in paper no. 16.

Applicant's substitute specification on 08/13/03 (paper no. 12) is entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 – 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 2 line 14 and in claim 8, line 14, the word "entire" is not supported by the specification and drawings. Refereeing to the Figures of the instant application, on the upper right side of Figure 1 a solid plastic plug (E) and Steel pin (D) are provided. The plug is to be inserted into the hollow tube (C) and the pin is inserted through the hollow tube and the plug covers part of the tip end of the hollow tube. Therefore, the sliding inner tube (B) cannot slide the **entire** length of the hollow outer tube (C).

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Claim Rejections -35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rainey (US Patent No. 5,634,856) in view of Turner (US Patent No. 5,575,473).

Rainey discloses a lightweight practice bat (column 1, line 6 indicates that it can be used in baseball) comprising:

- A hollow open-ended outer tube of uniform inner and outer diameter for its full length (23);
- A solid plug affixedly attached within an outer end of said hollow outer tube opposite to the handle (28).

Rainey fails to explicitly suggest a hollow sliding inner tube but he shows a bearing ball element (30) that is guided solely by said hollow outer tube. In column 3, lines 23-25, it is indicated that the striking member 30 **may be** a bearing ball element. The term "may be" indicates that the shape of the sliding element is not critical. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any shape to the sliding inner element including a hollow tube.

Rainey discloses the invention as recited above but fails to explicitly teach the use of an end cap. However Turner is one example that teaches the use of end caps on sporting devices (for example refer to item 23 on Fig. 5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an end cap as taught by Turner in the Rainey device in order to promote safety by covering sharp edges of devices.

Rainey shows a hollow handle with inner and outer diameter for its full length having an open inner end (24) and a closed outer end (referring to Fig. 2, the handle is considered to be closed at the outer end because plug 32 is provided or flag extension 34 is provided with the handle); but, he fails to show a uniform inner and outer diameter for the full length of the handle. However it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide a uniform or non-uniform handle since the Applicant has not shown the criticality for the claimed uniformity of the handle. It appears that Rainey's handle would accomplish similar purpose.

Claims 3, 5- 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Piazza (US Patent No. 3,578,801).

Rainey in view of Turner fails to explicitly teach the hollow tube, the inner tube, the plug, and the end cap to be made of plastic. However, Piazza discloses a bat wherein the

outer hollow tube is made of plastic (column 1, line 55) and wherein the sliding inner tube is made of plastic (column 1, line states that the sliding element is plastic). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide plastic elements as taught by Piazza in the Rainey device in order to provide a device that is simple, easily and inexpensively manufactured.

With respect to the plug to be made of plastic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plastic plug, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Tyner (US Patent No. 6,254,498)

Rainey in view of Turner fails to explicitly include a handle that is made of foam rubber. However, Tyner discloses a handle that is made of a foam rubber (column 4, lines 20-21). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a handle that is made of a foam rubber as taught by Tyner in the Rainey's device in order to provide a bat that absorbs shock without discomfort to the batter as stated on column 4, lines 25-26 of the Tyner's invention. With respect to the method claims of 8-13, they appear to be directed to the obvious method of using the Rainey device.

Response to Arguments

Applicant's arguments filed 01/05/04 have been fully considered but they are not persuasive. Applicant argues that Rainey does not teach or suggest the use of an inner hollow tube. However, Figure 2 shows a hollow outer tube (22) with a hollow striking member (30) that slides inside the hollow outer tube (22) freely. As stated on the previous office action, this item (30) is indicated that it may be a bearing ball element (col. 3, lines 23-25). The term "may be" indicates that the sliding element could be a lot of other things. Therefore item (30) could be any shape including a tube. In addition, since Applicant has not shown the criticality for the claimed tube shape, it appears that the hollow spherical element of Rainey would accomplish similar purpose. And those skilled in the art may use a variety of shapes for the inner sliding element without departing from the spirit and scope of the Rainey's invention.

Applicant also argues that the Rainey referenced teaches away from a lightweight sliding tube, however it should be noted that this feature upon which applicant relies is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Garbe can be reached on (703) 308-1207. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL
02/26/04


Stephen P. Garbe
Primary Examiner